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**MAILED**

DEC 14 2010

In re Application of  
Kirmoto, et al.  
Application No. 10/826,173  
Filed: April 16, 2004  
Atty. Dkt. No. SIC-04-021

: **OFFICE OF PETITIONS**  
: **DECISION DISMISSING PETITION**  
: **UNDER 37 CFR 1.183**  
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This is a decision on the petition filed August 30, 2010 under 37 CFR 1.183 to waive the requirements of 37 CFR 1.172. Receipt is acknowledged of the required petition fee of \$400.00.

Petitioners request waiver of the requirement that all joint inventors sign any supplemental declaration in a broadening reissue application.

The petition under 37 CFR 1.183 is dismissed.

**BACKGROUND**

1. U.S. Patent No. 6,557,671 (the '671 patent) issued to Kirmoto, et al. on May 6, 2003.
2. A broadening reissue application (the present application) was filed on April 16, 2004, for the reissue of the '671 patent, and it was assigned application number 10/826,173. The reissue declaration to support the filed reissue application was signed by all of the joint inventors.
3. A supplemental reissue declaration under 37 CFR 1.175(b)(1) was filed August 19, 2010, along with a the present petition under 37 CFR 1.183 requesting acceptance of the supplemental reissue declaration signed by less than all of the joint inventors.
4. The petition is accompanied by a supplemental reissue application declaration by the inventors, signed by two of the three inventors named in the application. The declaration is not signed by joint inventor Yamahita. It is for this supplemental declaration that the petition requests acceptance, via suspension or waiver of the regulations.
5. The petition proffers a showing for the purpose of establishing that the non-signing inventor is unavailable to sign the supplemental reissue declaration. The petition sets forth (a) the efforts made on behalf of the assignee to contact the non-signing inventor and obtain the requisite signature on the supplemental declaration, and (b) the lack of success of such efforts.
6. Petitioners assert that the inventor cannot be found and is not available at his last known address.

## DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1), requires that:

"For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant."

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by all inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventor(s).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the 37 CFR 1.172 requirement that the 37 CFR 1.175 supplemental declaration be signed by all of the inventors.

The petition is not supported by any supplemental evidence to establish the unavailability of the non-signing inventor.

To the extent that petitioners continue to assert that the non-signing inventor cannot be located, petitioners are to submit supporting documentation that sufficiently establishes that despite diligent effort, the non-signing inventor cannot be located. A statement of facts should be submitted that fully describes the exact facts that are relied on to establish that a *diligent effort* was made to locate the non-signing inventor. The statement of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay, will not normally be accepted. At the very least, a search of the internet, human resource records, telephone directories, etc. should be undertaken in regions where it is suspected the non-signing inventor may reside. See MPEP 409.03(d). Petitioner should reference and supply evidence of any such searches in a renewed petition.

## CONCLUSION

In view thereof, the petition under 37 CFR 1.183 is DISMISSED.

Any request for reconsideration under 37 CFR 1.183 must be submitted within two months of the mail date of this decision. Extensions of time pursuant to 37 CFR 1.136 are available.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Mail Stop PETITIONS  
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Registered users of EFS-Web may alternatively submit further correspondence with respect to this matter via EFS-Web.<sup>1</sup>

Telephone inquiries concerning this decision should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3215.

/Kenneth M. Schor/

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<sup>1</sup> <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>